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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,143	02/18/2004	Yuh-Cheng Wu	13906-141001 / 2003P00613	6080
32864	7590	07/06/2006	EXAMINER	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			CAO, PHUONG THAO	
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DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/781,143	Applicant(s) WU ET AL.	
	Examiner Phuong-Thao Cao	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06/30/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to Application filed on 02/18/2004.
2. Claims 1-13 are pending.

Information Disclosure Statement

3. The Information Disclosure Statement (IDS) filed by Applicant on 06/30/2005 has been received and considered. A copy of the reviewed IDS is enclosed with the office action.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1 and 7-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 12, this claim is a computer system claim but recites no hardware limitation.

Regarding claims 1 and 7-13, these claims recite the process of obtaining information contained in multiple knowledge bases, but fail to recite a tangible result, a requirement for compliance with the provisions of 35 U.S.C. § 101 in view of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, published on 26 October 2005, which can be found at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf, particularly with respect to ANNEX IV Computer-Related Nonstatutory Subject Matter, beginning on page 50.

For a result to be tangible, it must be more than just a thought or a computation; it must have real-world value rather than an abstract result. For instance, note that the limitations of claims 2-6 are not rejected, since they recite the function of sending the search results back to the application system, whereas (for instance), claim 1 merely cites 'obtaining search results' as the result.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Brill et al. (Publication No US 2004/0260692).

As to claim 1, Brill et al. teach:

“A computer-implemented method for obtaining information contained in multiple knowledge bases” (see [0030] and [0044]), the method comprising:

“receiving a request for information from an application system” (see [0023]);

“using the request to create a first search query” (see [0023] wherein the disclosure of the search component processing the search request against the dataset inherently implies the inclusion of generating a search query as illustrated in Applicant’s claim language);

“using the first search query to obtain a first search result that includes information contained in the first knowledge base” (see [0023] wherein the dataset 104 is equivalent to Applicant’s “first knowledge base”);

“using the first search result to automatically create a second search query” (see [0028] wherein using the search terms to perform another inherently includes the creating a second search query in order to search the dataset); and

“using the second search query to obtain a second search result that includes information contained in a second knowledge base” (see [0028] and [0030] wherein the dataset 206 is equivalent to Applicant’s “second knowledge base”).

As to claim 2, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Brill et al. teach:

“sending the first and second search results back to the application system” (see [0054] and [0057] wherein a user implies an application system because user must use some application system to request and obtain information as disclosed).

As to claim 3, this claim is rejected based on arguments given above for rejected claim 2 and is similarly rejected including the following:

Brill et al. teach:

“processing the first and second search results” (see [0028], [0030], [0034] and [0049]-[0054]).

As to claim 4, this claim is rejected based on arguments given above for rejected claim 3 and is similarly rejected including the following:

Brill et al. teach:

“using the first search result to obtain additional information from the first knowledge base” (see [0054] wherein first system is equivalent to Applicant’s “first knowledge base” and the disclosure of initiating a second search on the first system implies the obtaining additional information as illustrated in Applicant’s claim language; also see [0053]); and

“sending additional information obtained from the first knowledge base back to the application system” (see [0054] wherein first system is equivalent to Applicant’s “first knowledge base”, user implies Applicant’s “application system”, and result of the second search is equivalent to Applicant’s “additional information”; also see [0053]).

As to claim 5, this claim is rejected based on arguments given above for rejected claim 3 and is similarly rejected including the following:

Brill et al. teach:

“wherein processing the first and second search results including filtering the first and second search results according to a set of predefined filtering rules” (see [0036] and [0049]-[0052])

As to claim 6, this claim is rejected based on arguments given above for rejected claim 3 and is similarly rejected including the following:

Brill et al. teach:

“wherein processing the first and second search results includes classifying the first and second search results according to a set of predefined classification rules” (see [0047]-[0049]).

As to claim 7, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Brill et al. teach:

“wherein using the first search result to automatically create a second search query including using the first search result along with a set of predefined search rules to automatically create the second search query” (see [0028], [0053] and [0054] wherein question hierarchy is an example of a set of predefined search rules; also see [0049])

As to claim 8, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Brill et al. teach:

“extracting information from the first search result” (see [0054] wherein the refining terms is information extracted from the first search result); and

“including the extracted information within the second search query” (see [0054]).

As to claim 9, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Brill et al. teach:

“using the first search query to obtain a first search result including obtaining the first search result directly from the first knowledge base” (see [0073]); and

“using the second search query to obtain a second search result includes obtaining the second search result directly from a second knowledge base” (see [0073]).

As to claim 10, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Brill et al. teach:

“using the first search query to obtain a first search result includes obtaining the first search result from a first search engine” (see [0030] and [0074]); and

“using the second search query to obtain a second search result includes obtaining the second search result from a second search engine” (see [0030] and [0074]).

As to claim 11, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Brill et al. teach:

“wherein the application system includes a call-center application” (see [0041] wherein the disclosure of a technical support database implied the inclusion of a call-center application as illustrated in Applicant’s claim language).

As to claim 12, Brill et al. teach:

“A computer system for obtaining information contained in multiple knowledge bases” (see [0030] and [0044]), the computer system being programmed to:

“receiving a request for information from an application system” (see [0023]);

“using the request to create a first search query” (see [0023] wherein the disclosure of the search component processing the search request against the dataset inherently implies the inclusion of generating a search query as illustrated in Applicant’s claim language);

“using the first search query to obtain a first search result that includes information contained in the first knowledge base” (see [0023] wherein the dataset 104 is equivalent to Applicant’s “first knowledge base”);

“using the first search result to automatically create a second search query” (see [0028] wherein using the search terms to perform another inherently includes the creating a second search query in order to search the dataset); and

“using the second search query to obtain a second search result that includes information contained in a second knowledge base” (see [0028] and [0030] wherein the dataset 206 is equivalent to Applicant’s “second knowledge base”).

As to claim 13, Brill et al. teach:

“A computer-readable medium having computer-executable instructions contained therein for performing a method (see [0030] and [0044]), the method comprising:

“receiving a request for information from an application system” (see [0023]);

“using the request to create a first search query” (see [0023] wherein the disclosure of the search component processing the search request against the dataset inherently implies the inclusion of generating a search query as illustrated in Applicant’s claim language);

“using the first search query to obtain a first search result that includes information contained in the first knowledge base” (see [0023] wherein the dataset 104 is equivalent to Applicant’s “first knowledge base”);

“using the first search result to automatically create a second search query” (see [0028] wherein using the search terms to perform another inherently includes the creating a second search query in order to search the dataset); and

“using the second search query to obtain a second search result that includes information contained in a second knowledge base” (see [0028] and [0030] wherein the dataset 206 is equivalent to Applicant’s “second knowledge base”).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong-Thao Cao whose telephone number is (571) 272-2735. The examiner can normally be reached on 8:30 AM - 5:00 PM (Mon - Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PTC

June 23, 2006

Inde S. Wassum
Primary Examiner
Art Unit 2167